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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,570	12/28/2001	James P. Campbell	2001-120-TAP	1548

7590 01/08/2004

STORAGE TECHNOLOGY CORPORATION
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Louisville, CO 80028-4309

EXAMINER

TRAN, KHOI H

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 01/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,570

Applicant(s)

CAMPBELL ET AL.

Examiner

Khoi H Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 and 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6 and 7 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☒ Claim(s) 8-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/28/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

KHOI H. TRAN
PRIMARY EXAMINER

DETAILED ACTION

Response to Amendment

1. The amendment file on November 26, 2003 was not completely proper. New claims 8-13 should have been renumbered as claims 16-23, and claims 8-15 should have been canceled. However, in order to speed up the prosecution process, claims 8-13 from paper No.10, filed on November 26, 2003 will be addressed as new claims 8-13. Claims 14 and 15 from paper No. 7, filed on October 20, 2003 have been canceled.

Election/Restrictions

2. Newly submitted claims 8-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The original claims 1-7, which have been amended, drawn to a method of scaling a storage library, classified in class 700, subclass 214.

The new grouping of claims 8-13 is directed to a scalable storage library with the particulars of the cell arrays, robot mechanism, and cartridge player, classified in class 369, subclass 30, 39, or 75.1.

The inventions would be distinct, each from the other because inventions II (new grouping) and I (original claims) are related as combination and subcombination. Inventions in this relationship would be distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In this case, the combination of invention II as claimed would not required the particulars of the subcombination as claimed because

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the combination would not required the particulars of increasing the horizontal width and length of the storage library for patentability. The subcombination would have separate utility such as for increasing the size of a storage library without a cartridge player, or without a robot mechanism. The subcombination would have separate utility such as for increasing the size of a book storage library.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-13 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

3. The drawings are objected to because Figure 5 improperly reflects a vertical storage cell arrangement. The storage cells are supposed to be horizontally disposed per the claims. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 2-5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Method claims 2-

5 are improperly dependent upon apparatus claims 8 and 9. Therefore, claims 2-5 have been withdrawn from further consideration.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan 6,457,928 and Ryan 6,438,623 (incorporated into Ryan '928 by reference).

Ryan '928 discloses a method of scaling a storage library per claimed invention. The method comprises providing the library having a plurality of horizontal storage cell arrays, wherein each horizontal storage cell array is comprised of storage cells arranged in a horizontal plane of rows and columns. The library comprises plurality of media cartridge players and plurality of robot mechanisms that move along a horizontal

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storage cell array. The vertical distance between the horizontal storage cell arrays is limited by the size of the robot mechanisms (Figure 1 of Ryan '928 and Figures 103 of Ryan '623). The robot mechanisms can dismount cartridges from storage cells to be transported to the at least one media cartridge player and mount cartridges transported from the at least one media cartridge player into cartridge storage cells. The method comprises increasing the horizontal width and horizontal length of the library by increasing the horizontal width and the horizontal length of the storage cell arrays.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan 6,457,928 and Ryan 6,438,623 (incorporated into Ryan '928 by reference).

Ryan '928 discloses all method steps per claimed invention. However it is silent as to the specific of increasing the vertical height of the library by vertically stacking additional horizontal storage cell arrays, and wherein the vertical distance between the horizontal storage cell arrays is limited by the size of the robot mechanism.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have vertically stacked additional storage cell arrays to Ryan '928 library because it obviously increases the library storage capacity vertically. Such

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modification would only involve a duplication of the horizontal storage cell array vertically.

Response to Arguments

9. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

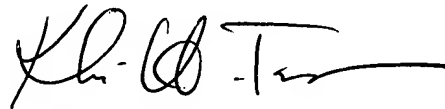
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H Tran whose telephone number is (703) 308-1113. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on (703) 308-1113. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to read 'Khoi H Tran', with a stylized flourish at the end.

Khoi H Tran
Primary Examiner
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KHT
01/06/2004